

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. After amending the claims as set forth above, claims 10, 23-24, 35-36, and 40-43 remain pending in this application, and are submitted for reconsideration.

Claims 1-4, 7-9, 18-22, 32-34, and 37-39 are canceled.

Applicant wishes to thank the Examiner for indicating that claims 10, 40, and 41 would be allowable if rewritten into independent form including all the features of the base claim and any intervening claim. Claims 10, 40, and 41 have been so rewritten. Claims 23 depends from claim 10.

**Rejection of claims 37-38 under 35 U.S.C. 112**

Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph. These claims have been canceled, which renders the rejection of these claims moot. For at least this reason, favorable reconsideration is respectfully requested.

**Prior art rejections of claims 1-4, 7-9, 18-22, 32-34, and 37-39**

Claims 1-4, 7-9, 18-22, 32-34, and 37-39 are rejected over the prior art. These claims have been canceled, which renders the rejections of these claims moot. For at least this reasons, favorable reconsideration of the rejections is respectfully requested.

**Rejection of claim 42 based on Clark and Manalang**

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,721,178 ("Clark") in view of U.S. Patent Application Publication 2002/0165641 ("Manalang"). This rejection is traversed because Clark, Manalang, or any reasonable combination thereof fails to teach or suggest the claimed invention.

For example, claim 42 recites a cart comprising a work platform including a work surface and compartments for containing items, an electronic keyless entry system for unlocking the compartments of the work platform, a base, and a height adjustment mechanism. Clark does not teach or suggest these features. For example, Clark does not teach a plurality of compartments but merely discloses a single pull-out keyboard tray 70. (Figs. 4A-4B and column 11, lines 40-50 of Clark.) The PTO asserts that "[i]t is old and well

known to provide plural storage compartments on movable carts for accommodating additional items, and it would have been obvious...to provide at least one further compartment on the cart of Clark...for the purpose of accommodating or storing additional items.” (Paragraph 14 of the Office Action.) This rejection is improper because no prior art has been set forth to provide a teaching of a plurality of compartments used in the mobile clinical workstation of Clark.

The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) has not removed the requirement that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Indeed, KSR emphasized cases where all features are known.<sup>1</sup> Furthermore, the PTO’s examination guidelines for determining obviousness in view of *KSR*<sup>2</sup> (“the PTO guidelines”) suggests that all elements (when the references are combined) need to be known in the art to support a conclusion of obviousness.<sup>3</sup> The unsupported statement that a plurality of compartments is old and known in the art does not establish that such compartments in relation to the other features of the claimed invention

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<sup>1</sup> The Supreme court noted three cases *United States v. Adams*, 383 U.S. 39 (1966), *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), and *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976) which all dealt with the issue of whether known elements combined together would be obvious. These statements reinforce the concept that the elements of the claim have to be known in the art before they are determined to be combinable or not.

<sup>2</sup> “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*” (Pages 57526-57535 of the Federal Register, Vol. 72, No. 195.)

<sup>3</sup> For example, if a finding that all claim elements were known in the prior art cannot be made, then the rationale of combining prior art elements according to known methods cannot be used. (Page 57529.) If a finding that the substitution of one known element for another known element (which suggests a teaching of the known elements in the prior art) cannot be made, then the rationale of simple substitution of one known element for another cannot be used. (Page 57530.) If a finding that a method of enhancing a particular class of devices, methods or products based upon the teaching of such an improvement in other situations cannot be made, then the rationale of the use of known techniques to improve similar devices in the same way cannot be used. (Page 57530.) If a finding that a particular known technique was recognized in the art (which suggests a teaching of the technique in the prior art) cannot be made, then the rationale of applying a known technique to a known device, method, or product ready for improvement cannot be used. (Page 57531.) If a finding that there are known options with the grasp of a person of ordinary skill (which suggests a teaching of the known options in the prior art) cannot be made, then the rationale of obvious to try cannot be used. (Page 57532.) If a finding that design incentives or other market forces could have prompted one of ordinary skill to vary the prior art in a predictable manner (which suggests a teaching of the predictable manner in the prior art) cannot be made, then the rationale of the known work in one field of endeavor may prompt variations of it for use in either the same field or a different one cannot be used. (Page 57533.) If a finding that a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention (which suggests that the prior art when combined teaches all the elements of the claimed invention) cannot be made, then the rationale of some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify or combine prior art reference teachings cannot be used. (Page 57534.)

exist in the prior art. Because no prior art has been set forth establishing the plurality of compartments of claim 42, a case of prima facie obviousness has not been established, and the rejection is improper.

Also, the proposed modification would seem to suggest that the plurality of compartments would presumably take the form of a plurality of pull-out keyboard trays 70 because the PTO considered the keyboard tray 70 to be the “compartment” of claim 42, and a plurality of compartments would mean a plurality of the keyboard trays. The assertion that a plurality of keyboard trays 70 are to be used to accommodate or store additional items would change the function of the keyboard tray, a situation quite different from *Ex parte Smith*, Board of Patent Appeals and Interferences (decided June 25, 2007) (precedential decision). In *Smith*, a rejection based on obviousness was upheld because the elements that were combined from various references did not change their respective functions,<sup>4</sup> which is not the case here. Thus, the obvious rejection is improper.

Furthermore, the PTO guidelines suggest that the combination is not obvious because of the change in function of the keyboard tray of Clark. In particular, the PTO guidelines provide that a finding of obviousness based on combining prior art elements according to known methods to yield predictable results is not established if there is no finding that each element merely would have performed the same function as it did separately. (Page 57529, vol. 72, No. 195 of the Federal Register.)

Because a plurality of compartments is not set forth in Clark, and the function of the keyboard tray would change if used as a storage compartment, the obvious rejection is improper, and should be withdrawn.

Furthermore, Clark does not teach or suggest a keyless entry system, as correctly pointed out at paragraph 14 of the Office Action. Manalang teaches a medical cart for providing a keyless locking system for drawers containing narcotics. (Abstract of Manalang.) This combination is improper because Clark and Manalang teach different apparatuses. Clark teaches a mobile clinical workstation with a keyboard tray 70 and is used for mounting a computer terminal. (Abstract and column 11, lines 40-50 of Clark.) In contrast, Manalang

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<sup>4</sup> “[E]ach of the elements of Wyant, Dick, and Ruebens combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results.” *Ex Parte Smith* at 22.

teaches a medical chest with a plurality of drawers. The devices of Clark and Manalang have completely different functions, and one with ordinary skill in the art would not have a reason to use the workstation of Clark as a storage chest because it would change the function of the workstation of Clark. Thus, the rejection based on this combination is non-obvious.<sup>5</sup>

Also, even assuming that Clark disclosed a plurality of keyboard trays 70 (and the Applicant maintains that Clark does not), there is nothing to teach or suggest that these trays have the ability to be closed like a drawer. The keyboard tray 70 of Clark does not have such an ability (see Fig. 4A and 4B of Clark), and there is nothing to teach or suggest a keyboard tray with such an ability. The fact that the keyboard tray 70 (or a plurality of keyboard trays 70) does not have the ability to close like a drawer makes a locking mechanism inapplicable, and thus non-obvious. Also, there is no reason or teaching that would lead one with ordinary skill in the art to want to have such a locking mechanism for the keyboard trays. Why would one with ordinary skill in the art want to lock one keyboard tray but not another? Thus, Manalang does not cure the deficiencies of Clark, and the rejection is improper.

For at least these reasons, favorable reconsideration of the rejection is respectfully requested.

#### Rejection of claim 43 based on Clark

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark. This rejection is traversed because Clark fails to teach or suggest the claimed invention.

For example, claim 43 recites a cart comprising: a work platform; a base; and a height adjustment mechanism with a stationary casing, a telescoping casing, a driver, and an actuator for controlling the driver, wherein the actuator is disposed above the compartment and on the work platform. Clark does not teach or suggest this combination of features.

For example, Clark does not teach that the actuator is disposed above the compartments and on the work platform. The PTO asserts that “[i]t is quite well known to provide a storage or accommodation space, such as drawer, for elements wherein mechanical portions not intended for storage in the space are not positioned in that space, and as such, it would have been obvious...to provide the actuator at a location above the compartment

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<sup>5</sup> As previously mentioned, when a modification changes the function of an element changes functions, such a modification is non-obvious.

taught by Clark...for the purpose of preventing interference between the items located in the compartment and the actuator.” (Paragraph 15 of the Office Action.) This rejection is improper because no prior art has been set forth to provide a teaching of an actuator disposed above the compartment and on the work platform.

As previously mentioned, the Supreme Court in *KSR* has not removed the requirement that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Furthermore, the PTO guidelines suggest that all elements (when the references are combined) need to be known in the art to support a conclusion of obviousness.<sup>6</sup> The unsupported statement that it is quite well known to provide a storage or accommodation space, such as drawer, for elements wherein mechanical portions not intended for storage in the space are not positioned in that space does not establish that that an actuator disposed above the compartment and on the work platform in relation to the other features of the claimed invention exist in the prior art. Because no prior art has been set forth establishing an actuator disposed above the compartment and on the work platform of claim 43, a case of prima facie obviousness has not been established, and the rejection is improper.

Also, it is noted that the rejection seems to suggest that the arrangement of the workstation of Clark is inoperable by asserting that placing the release lever above the actuator at a location above the keyboard tray 70 prevents interference between the keyboard in the keyboard tray 70 and the release lever. By implication, the PTO is asserting that the release lever 42 interferes with the keyboard placed in the keyboard tray 70. However, no evidence has been set forth to supporting such an assertion. Thus, one with ordinary skill in the art would have no reason to make the proposed modification, thus making the rejection based on such a modification improper. Because there is no reason to make the proposed modification to the device of Clark, the rejection based on Clark is improper and should be withdrawn.

For at least these reasons, favorable reconsideration of the rejection is respectfully requested.

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<sup>6</sup> See footnote 3.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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